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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/827,559

04/19/2004

Yoshiki Katoh

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27572 7590 05/30/2008  
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EXAMINER

FORD, JOHN K

ART UNIT

PAPER NUMBER

3744

MAIL DATE

DELIVERY MODE

05/30/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/827,559	<b>Applicant(s)</b> KATOH ET AL.	
	<b>Examiner</b> John K. Ford	<b>Art Unit</b> 3744	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 January 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12, 15-25 and 39 is/are pending in the application.
- 4a) Of the above claim(s) 4-12, 15-20 and 23-25 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-2, 21, 22, 39 is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

Applicant's response of January 28, 2008 is acknowledged and the matching of references in the Japanese Patent Office rejection ("Notification of Reason(s) for Refusal") and the references cited by applicant (English language equivalents of certain Japanese references) is appreciated. Applicant's submission of a translation of the claims (as translation JP 2005-207716) being examined by the JPO when they issued the "Notification of Reason(s) for Refusal" is also appreciated.

Has a claim substantially similar to current claim 1 been allowed in Japan? If so, please so indicate. If not, please provide a translation of any allowed independent claim(s) from the Japanese prosecution that most closely resembles claim 1. The examiner is still having great difficulty comprehending the rejections set forth in the "Notification of Reason(s) for Refusal". A copy and translation of 2002-130985 (the publication corresponding to JP 2000-318443) have also been received.

This application is in condition for allowance except for the following formal matters:

Applicant must cancel claims 23-25 in response to this action. Applicant's election between inventions was made without traverse as evidenced by page 2 of applicant's February 27, 2007 response. While it is normal procedure to rejoin dependent claims directed to different species, where a generic claim is allowed, applicant is requesting that claims 23-25 directed to a different statutory class of

invention be rejoined. The examiner does not believe this is prudent even possible for the following reasons.

In Ex parte Lyell, 17USPQ2d 1548 (BPAI 1990), the Board found claims similar to these to be indefinite (a claim directed to an automatic transmission workstand and method of use held to be ambiguous under 35 USC 112, second paragraph). The examiner would strongly advise cancellation of these claims to avoid any potential future problems in litigation including the risk of invalidation. Dependent claims when they are read in combination with the claim from which they depend are in effect a new independent claim with all of the limitations of both claims, thereby falling within the potential reach of Lyell.

While the examiner is aware that the Board also decided a case after Lyell (the name of which the examiner does not recall) which suggests the exact opposite conclusion as reached in Lyell (without ever mentioning Lyell) it appears to the examiner that even more recently decided cases by at least one District Court (IXPL v. Amazon, 72 USPQ2d 1469, (E.D. Va. 2004) have followed the rationale of Lyell and have invalidated these “hybrid” claims that span different statutory categories of invention.

Counsel is encouraged to do his own legal research in this area, but it seems that, in the final analysis, cancellation of claims 23-25 is the most prudent course of action and avoids a thorny problem in an ambiguous area of the governing law where there is no predictable outcome.

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 25 USPQ 74, 453 O.G. 213, (Comm'r Pat. 1935).

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John K. Ford whose telephone number is 571-272-4911. The examiner can normally be reached on Mon.-Fri. 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cheryl Tyler can be reached on 571-272-4834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John K. Ford/  
Primary Examiner, Art Unit 3744